

Serial No. 10/716694  
60,130-1779  
03MRA0263

### REMARKS

Applicant wishes to thank the Examiner for the detailed remarks, the allowance of claims 5-14 and the allowability of claims 3 and 4.

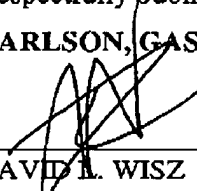
Claims 1-2 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Tanaka* (JP 2002-89611) in view of *Monaco* (6357612). Applicant respectfully traverses these rejections as there is absolutely no teaching, suggestion, or motivation to modify *Tanaka* (JP 2002-89611) in view of *Monaco* (6357612) as proposed. The Examiner admits that *Tanaka* lacks the teaching of a radial passage through the piston cylinder transverse to the axis to provide communication with outer cylinder. *Tanaka* makes no reference to a valve other than a temperature compensating valve. *Monaco* provides no teaching whatsoever with regard to temperature compensating valves. *Monaco* discloses only check valves 70, 72 and a pair of bleed apertures 80 and 82. "Apertures 80 and 82 are rapidly closed during cushioning of buff and draft impacts and do not flow appreciable amounts of hydraulic fluid from chambers 58 and 60." [Col 8, lines 20-22.]. The check valves themselves are mounted to the inner cylinder 44 at particular linear locations [See Figure 11] and provide the flow between the chambers. That is, hydraulic fluid flows through the strategically placed check valves. *Tanaka* discloses that the temperature compensation valve is located at an end of the cylinder and along the axis of rod 6 for communication with an auxiliary chamber 25. Placing valves in strategic linear portions along the length of *Tanaka* for flow through the valves as taught by *Monaco* provides no benefit to *Tanaka* especially considering that *Tanaka* utilizes a remote auxiliary chamber anyway. A proper suggestion or motivation to make a combination requires some benefit to result from the combination. When the additional teachings of a secondary reference do not provide any benefit to the arrangement disclosed in a primary reference, no prima facie case of obviousness exists. Because this combination provides no benefit and, therefore, is improper, there is no prima facie case of obviousness.

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Simply, there is no motivation to combine *Tanaka (JP 2002-89611)* in view of *Monaco*. The only motivation to make the combination as proposed is by following the knowledge disclosed within the present invention. This is impermissible usage of hindsight in an attempt to recreate Applicants device. Accordingly, claims 1-2 are properly allowable.

Applicant respectfully submits that this case is in condition for allowance. If the Examiner believes that a teleconference will facilitate moving this case forward to being issued, Applicant's representative can be contacted at the number indicated below.

Respectfully Submitted,  
**CARLSON, GASKEY & OLDS, P.C.**



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